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Paper Number 13

In re application of
Munehiro DATE et al.
Serial No.: 09/434,498
Filed: November 5, 1999
For: REVERSIBLE HEAT-SENSITIVE
PAPER AND METHODS FOR
WRITING INFORMATION

DECISION ON PETITION

This is a decision on the petition filed on October 1, 2001 (Paper No. 11) to request withdrawal of a restriction requirement and an election of species requirement against pending claims 1 and 3-7 given in the Office Action mailed August 29, 2001 (Paper No. 9). Although applicants did not indicate the rule under which the petition was filed, it is noted that a petition from a restriction and/or election of species requirement is considered under 37 CFR 1.144.

DECISION

The applicants' principal argument is that the examination of the totality of all pending claims does not impose a serious (or undue) burden on the examiner because, "the examiner has already examined all claims on the merits," and they cite MPEP 803 in support of their position.

A review of the restriction requirement set forth in Paper No. 9, as well as a perusal of the Office Action in which all the originally filed claims, 1-5, in Paper No. 7 were searched, examined and rejected, followed, further, by a comparison of the limitations in the originally filed claims (1-5) *vis-à-vis* the limitations in the presently pending claims (1 and 3-7) reveals that applicants' position is well-founded. The reasons are detailed below.

Originally filed claims 1 and 2 were drawn to a reversible heat-sensitive paper whilst original claims 3 to 5 were directed to a method of writing information on a reversible heat-sensitive paper. The examiner searched and examined all these claims on the merits and rejected them (cf. Paper No. 7). In response to that the applicants filed an amendment (cf. Paper No. 8) in which they:

- Deleted original claim 2 and incorporated the limitation of that claim into claim 1.
- Amended original claims 3 to 5 with respect to the language in the claims, rather than the incorporation of any new limitations, presumably, to improve the clarity of the claims.

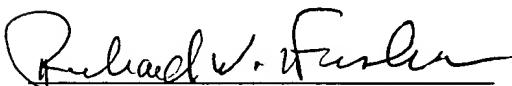
- Introduced new claims 6 and 7 drawn to a method of writing information on a reversible heat-sensitive paper and to a paper, respectively.

Turning now to the examiner's grouping of inventions in the restriction requirement in Paper No. 9, it is observed that the groups are: Group I embracing claims 1 and 7 (the latter depending on claim 1) and Group II encompassing claims 3 to 6. The implication from a restriction requirement based on the above groups is very clear, *viz.*, claims 1 and 3 to 5 are patentably distinct and that there would have been serious or undue burden to search and examine these claims. However, such a position is undermined by the plain fact that the examiner had searched, examined and rejected original claims 1 and 3 to 5 in Paper No. 7. Noting that the presently amended version of claims 1 and 3 to 5, for the reason elucidated in the second "bullet" above, are not different in any patentably material sense from originally filed, searched and examined claims 1 to 5, the restriction requirement is clearly untenable. That is, it is improper to have restricted claim 1 (of Group I) from claims 3 to 5 (of Group II). With respect to newly filed claims 6 and 7, since it is the examiner's position that there would have been no serious or undue burden to search and examine claim 6 together with claims 3 to 5 or, likewise, claim 7 together with claim 1, in view of the preceding discussion regarding the indivisibility of claims 1 and 3 to 5, it stands to reason that it is illogical to hold that there would have been serious or undue burden to search and examine claims 1 and 3 to 7.

The election of species requirement to elect an embodiment for "the process of imaging" (in examiner's own phraseology cf. page 3 in Paper No. 9), likewise, proves untenable since such a process was part and parcel of claims 1 and 3 to 5 which were already searched and examined by the examiner. Furthermore, since claim 7, which depends on claim 1, recites the absence of a opto-thermal conversion layer rather than any new positive process limitation, and, claim 6 was grouped with claims 3 to 5 the search and examination of which had caused the examiner no serious or undue burden, it is not at all apparent, nor is there is any objective argument of record, as to why the limitations in claim 6 and 7 and the clarification of the language of claims 1 and 3 to 5 would have justified an election of species requirement.

In view of the above discussion, having weighed both the examiner's position and the applicants' arguments, it is concluded that, on the balance, the restriction/election of species requirement imposed on claims 1 and 3 to 7 is incorrect. While, applicants have amended claim 5 in Paper No. 12 concurrently with the filing of their petition, that amendment merely turns the claim from being a dependent claim to an independent claim with no new limitations, that were not previously searched and examined, being thrown in. Hence, the present decision is unaffected by that amendment to claim 5. Accordingly, the examiner is directed to withdraw the restriction requirement in Paper No. 9, and set forth a non-final action on the merits of all pending claims, 1 and 3 to 7.

The petition is **GRANTED**.



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